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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/582,141	06/21/2000	JORG HOFMANN	MO5766/LEA3	1594

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EXAMINER

WOOD, ELIZABETH D

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 07/24/2003

18

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-18

Office Action Summary

Application No.

09/582,141

Applicant(s)

HOFMANN ET AL.

Examiner

Elizabeth D. Wood

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9 and 10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Specification

The examiner has not checked the specification to the extent necessary to determine the presence of **all** possible minor errors (grammatical, typographical and idiomatic). Cooperation of the applicant(s) is requested in correcting any errors of which applicant(s) may become aware of in the specification, in the claims and in any future amendment(s) that applicant(s) may file.

Applicant(s) is also requested to complete the status of any copending applications referred to in the specification by their Attorney Docket Number or Application Serial Number, **if any**.

The status of the parent application(s) and/or any other application(s) cross-referenced to this application, **if any**, should be updated in a timely manner.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

Art Unit: 1755

2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicants are advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-7 9 and 10 are rejected under 35 U.S.C. 103(a) as obvious over U.S. Patent No 5,714,428 to Le-Khac.

This application involves a double metal cyanide catalyst, method for the production thereof and method for the use thereof. The groups will be addressed together because it would appear that applicants consider the novelty of all embodiments of the invention to reside in the addition of a particular polycarbonate to the DMC catalyst composition.

Le-Khac discloses a DMC catalyst composition containing about 2 to about 80% of a functionalized polymer. The polymer can be a polycarbonate. This is substantially representative of the invention as claimed in the instant application. See particularly columns 4 and 5.

Art Unit: 1755

The Le-Khac disclosure differs from the amended claims in that the amended claims now require the polycarbonate to have hydroxyl end groups and a molecular weight below 12000. However, the amended claims would have been obvious because Le-Khac discloses that his functionalized polymer may be a polycarbonate and the molecular weight of his functionalized polymer can vary between 500 and 50,000. Furthermore, the reference teaches a species of polycarbonate considered to fall directly within the claimed limitations, i.e. poly (1,6-hexanediol carbonate).

Regarding methods of making the composition and methods of using the composition, they are well known as admitted by applicants in the specification and fairly shown by the prior art of record. Accordingly, there is nothing unobvious in the method steps.

Any minor differences in the limitations of the dependent claims have been considered. This statement is meant to include limitations such as preferred amounts of catalytic components which skilled artisans would be expected to optimize based upon the desired performance of the catalyst.

Furthermore, any such differences are deemed to be result-effective variables that one of ordinary skill in the art would be expected to manipulate to advantage. Additionally, such limitations can be considered to have been simply known as conventional to the artisan practicing in the art at the time the invention was made and/or were common practices which were so well known in the art that they would have been taken for granted. MPEP 706.02(a).

If applicants believe that one or more limitations are critical to the invention, then applicant should amend the claims to reflect such critical limitations as well as indicate where in the specification such critical limitations were discussed and demonstrated.

The limitations of all claims have been considered and are deemed to be within the purview of the prior art.

Regarding any unexpected results, there is no evidence that the presented results are in any way commensurate with what is now being claimed. The examples in the specification simply say "with polycarbonate" or "without polycarbonate" and do not elaborate on the identity of the specific carbonate being employed. Accordingly, there is no way of knowing whether or not the specific carbonate group now being claimed derives any unexpected benefits over polycarbonates generally, which are known and disclosed by Le-Khac. Since there is overlap between the reference and the instant

Art Unit: 1755

claims (the entire range of the claims is embraced by the reference disclosure) the claims remain obvious absent conclusive unexpected results.

Response to Arguments

Applicants' arguments filed June 19, 2003 have been fully considered but they are not persuasive for the reasons set forth in the hereinabove rejection and further discussed below.

Regarding applicants' comments that the examiner must show that patentees are solving the same problem as the inventor and provide reasons therefore, such is neither relevant nor correct. It has long been settled that as long as a skilled artisan can arrive at a claimed invention through knowledge of a prior art reference and motivation for the modification thereof, the claims are obvious irrespective of the reason for the modification. Furthermore, the specification provides no "problem" and in fact does not demonstrate that a specific correlation exists between the specific polycarbonates now being claimed and a reduction in induction time. As discussed above, the provided examples do not show a comparison between, for example, polycarbonates having the claimed molecular weight and polycarbonates having a higher molecular weight. As a result, applicants have provided no problem to be solved, the prior art does render the claimed invention obvious and the data in the specification is insufficient to compare anything except unidentified polycarbonates with functionalized polymers that are not even remotely the closest prior art of record.

Conclusion

Applicants are advised that any evidence to be provided under 37 CFR 1.131 or 1.132 and any amendments to the claims and specification should be submitted prior to final rejection to be considered timely. It is anticipated that the next office action will be a final rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth D. Wood whose telephone number is 703-308-3802. The examiner can normally be reached on M-F, 5:30-2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell can be reached on 703-308-3823. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Elizabeth D. Wood
Primary Examiner
Art Unit 1755

edw
July 22, 2003